

Attorney Docket No. P 66680US0
Appln. No. 09/831,377

5. Structural zinc strips and plates prepared by casting and rolling the zinc alloy of claim 3.

REMARKS

Attached, hereto, is the inventorship declaration in compliance with 37 CFR 1.52(a)(1)(i), as required by the Office Action.

Claims 2-5, presented hereby, contain the subject matter of claim 1.

With respect to the rejections under 35 USC 112, ¶ 1, and 35 USC 101, reconsideration is requested in view of claims 2-5, presented hereby.

Claim 1 was rejected under 35 USC 102(b) based on either DE 715 511, Cross et al. (U.S. Patent No. 3,843,416), Gervais (U.S. Patent No. 3,862,863), PL 102236 (abstract), JP 57140863 (abstract), or DE 3007850. Claim 1 was rejected under 35 USC 103(a) based on Gervais, PL 102236 (abstract), JP 57140863 (abstract), or DE 3007850. Reconsideration is requested with respect to the rejections under 35 USC 102(b) and 35 USC 103(a).

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis*

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added). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982).

None of the cited references describes or suggests the combination of the "alloy component" and "second alloy component" as presently claimed. Since each and every claim limitation, as arranged in the present claims, is not found any one of the cited references, none of the cited references would support a rejection of the present claims under §102(b). *Jamesbury Corp., supra*. As all the claim limitations are not taught or suggested by any one of the cited references, none of the cited references would support an obviousness rejection of the present claims under §103(a). *Royka, supra*.

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In particularly, Gervais describes the heat treatment for wrought zinc-aluminum alloys in a two-step-process making use of a zinc-aluminum eutectoid transformation. The reference fails to teach or suggest the "second alloy component" found in the present claims. Cross also fails to teach or suggest the "second alloy component" found in the present claims, as does JP 57140863 (abstract). Further, PL 102236 (abstract) fails to describe or suggest the proviso, whereby, the presently claimed alloy contains

- less than 0.1% by weight of copper,
- less than 0.1% by weight of iron, and
- lead only as an unavoidable impurity.

The absence of a limitation on the present claims from each of the cited references negates anticipation under §102(b) by any of the cited references. *Kolster Speedsteel A B, supra*. An obviousness rejection of the present claims under §103(a) would be "simply inadequate on its face . . . the cited references do not support each limitation of [the] claim." *Thrift*, 63 USPQ2d at 2008.

Favorable action is requested.

Respectfully submitted,

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